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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,004	10/19/2001	Yuri Itkis	FORTUNE 01-05.PA	4886
29747	7590	06/17/2005	EXAMINER	
QUIRK & TRATOS 3773 HOWARD HUGHES PARKWAY SUITE 500 NORTH LAS VEGAS, NV 89109			BROCKETTI, JULIE K	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No.	Applicant(s)	
	10/042,004	ITKIS ET AL.	
	Examiner	Art Unit	
	Julie K. Brockett	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 21, 2005 has been entered.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101, which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 13 and 62 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 11 and 60 respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing

one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 8, 35, 36, 56, 58 and 66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. All of these claims recite “the best bingo card”. It is unclear what makes a bingo card “the best”. This is a subjective term and applicant has established no limits on what makes the card “the best”. Therefore, one of ordinary skill in the art would not know what types of cards would be considered “the best” and therefore the claim is indefinite.

The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

A claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.

Claim 54 is rejected under 35 U.S.C. 112, fourth paragraph, for failing to limit the subject matter of a previous claim. Claim 54 states”...including means for automatically starting a new session of bingo games...” This limitation was recited in claim 1 on which claim 54 depends. Claim 1 states “...automatically re-enabling said generating of random numbers to initiate at

least one event selected from the group consisting of (a) a new bingo game in said session and (b) a new bingo session..." Therefore, claim 54 does not further limit claim 1.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 9, 15, 16, 20-22, 27, 30, 31, 33, 37, 39, 40, 44-46, 51 and 54-55 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fioretti, U.S. Patent No. 5,351,970 in view of Moore et al., U.S. Patent No. 6,729,959 B1. See 103 rejection below. Fioretti discloses a system and computer implemented method of playing a sequence of bingo in a first bingo session. The data processing means is a computer. A data processing means stores a plurality of bingo cards and generates statements having informational data thereon. The data corresponds to one or more of the bingo cards. A printer is in communication with the data processing means for printing the generated statements (See Fioretti Figs. 2 & 3; col. 9 lines 31-64). A means is used to automatically generate random numbers. The means to generate random

numbers is in communication with the processing means such that automatically generated random numbers are communicated to the data processing means (See Fioretti col. 14 lines 5-8). The data processing means determines whether one or more of the bingo cards correspond to a winning card by comparing the stored bingo cards with each of the numbers generated and storing a status of each bingo card as the numbers are generated. The means to generate random numbers being automatically disabled by the data processing means in response to the determination of one or more winning bingo cards by the data processing means (See Fioretti col. 8 lines 4-10; col. 13 lines 55-64; col. 14 lines 20-37). Since the system of Fioretti sequences through the bingo games within a session it is implicit that the data processing means further automatically re-enables the generating of random numbers to initiate at least one event selected from the group consisting of (a) a new bingo game in the session and (b) a new bingo session (See Fioretti col. 8 lines 34-45; col. 10 lines 25-34). A means is used to notify players of the status of the stored bingo cards corresponding to the generated statements (See Fioretti col. 10 lines 35-45) [claims 1, 30, 54, 56-67]. The data processing means is a microprocessor (See Fioretti Fig. 3; col. 13 lines 59-61) [claims 2, 31]. The means to automatically generate random numbers is a random number generator integrated in a microprocessor (See Fioretti col. 14 lines 9-12) [claim 3]. The means to notify the players of the status of their statements is a monitor, viewable by the players in communication with the data processing

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means (See Fioretti col. 10 lines 35-45 & Richardson, Patent No. 5,072,381 Fig 4) [claims 5, 33]. The data processing means has a computer network having one or more point of sale terminals (See Fioretti Fig. 2) [claims 9, 37]. Upon determination of one or more winning bingo cards, the data processing means further determines a prize associated therewith (See Fioretti col. 8 lines 15-20) [claims 15, 39]. The first session comprises at least two bingo games in sequence, each sequential bingo game initiated upon the occurrence of one or more predetermined events, the occurrence enabling the means to generate random numbers (See Fioretti col. 5 lines 54-55; col. 7 lines 16-20; col. 8 lines 34-45; col. 10 lines 25-29) [claims 16, 40]. The data processing unit further validates the statements upon presentation by comparing stored informational data corresponding to the statements with the information printed on the statements (See Fioretti col. 11 lines 22-35, 50-55) [claims 20, 44]. The information printed on the statements includes an identification code (See Fioretti col. 9 lines 50-52) [claims 21, 45]. The information printed on the statements includes a verification code (See Fioretti col. 9 lines 50-52) [claims 22, 46]. A cashier terminal is in communication with the data processing unit. The cashier terminal includes a monitor for displaying an outcome corresponding to the printed statements (See Fioretti col. 9 lines 31-64) [claims 27, 51]. If no games remain in the session, automatically initiating a new session of bingo games (See Fioretti col. 10 lines 25-30) [claim 55].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 17-19, 38, 41-43, 50, 63 and 67 are rejected under 35

U.S.C. 103(a) as being unpatentable over Fioretti, U.S. Patent No.

5,351,970. Fioretti discloses a point of sales terminal including a monitor for displaying a current status of at least one statement (See Fig. 2). Fioretti lacks in disclosing that the payout value associated with a statement is displayed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to display the payout value associated with a game or card [claims 14, 38, 63, 67]. By displaying the payout that a player could win, the player may be more inclined to play the game or may be further excited by the game and therefore enjoy it more by knowing how much money they could win on the game. Fioretti lacks in disclosing that the predetermined event for starting a next game is a predetermined time, completion of a previous game or a predetermined number of sales of bingo cards. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the predetermined event for starting a next game be a predetermined time, completion of a previous game or a

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predetermined number of sales of bingo cards [claims 17-19, 41-43] because Applicant has not disclosed that these events provide an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Fioretti's invention, to perform equally well with any event starting the next game since. Therefore, it would have been prima facie obvious to modify Fioretti to obtain the invention as specified in the claims because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Fioretti.

Fioretti discloses that the point of sale terminals include a data processing means that generates and prints one or more statements each including an identification and verification number (See Fioretti col. 9 lines 31-64). The data processing means displaying on a monitor an outcome corresponding to the statement upon first inputting the identification number (See Fioretti col. 12 lines 13-27) [claim 50]. Fioretti lacks in separately inputting both an identification and verification number. It would have been obvious to one of ordinary skill in the art to require players to input two numbers, i.e. identification and a verification number in order to validate a winning card [claim 50]. By requiring two numbers instead of one, an extra security measure is in place and players will have a more difficult time trying to forge two numbers.

Claims 1-5, 9, 14-22, 27, 30-33, 37-46, 50, 51, 54-56, 63 and 67 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over

Fioretti, U.S. Patent No. 5,351,970 in view of Moore et al., U.S. Patent No.

6,729,959 B1. Fioretti discloses all of the limitations mentioned above but does not specifically express automatically re-enabling the generating of random numbers to initiate a new game; however, the Examiner believes this limitation to be implicit in Fioretti. However, if one determines that it is not implicit, the limitation is clearly obvious in view of Moore. Moore teaches of a system to implement a bingo game in which the data processing means automatically re-enables the generating of random numbers to initiate at least one event selected from the group consisting of (a) a new bingo game in the session and (b) a new bingo session (See Moore Fig. 7; col. 6 lines 17-32; col. 11 lines 17-30) [claim 1]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the data processing means automatically re-enable the generation of random numbers and initiate a new game. By automatically conducting the bingo game, the games can be played at faster paces and one does not need to hire any operators in order to conduct the bingo game; therefore, it is simpler and easier for the casino to implement an automated game.

Fioretti lacks in disclosing a bingo ball hopper. Moore teaches of a means for automatically generating random numbers is through the use of a bingo ball hopper (See Moore col. 8 lines 57-64) [claims 4, 32]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a bingo ball hopper to select the numbers for the game. Bingo ball

hoppers are well known throughout the art as a way to select random numbers and it is obvious to use them in order to get a random selection of numbers that is visible to the player.

Claims 6-8, 34-36, 56, 57, 58, 65 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fioretti (alternatively in view of Moore et al.), in further view of Kellen, U.S. Patent No. 6,645,072 B1.

Fioretti lacks in disclosing displaying "the best bingo card". Kellen teaches of a bingo device in which a monitor displays a statement identification code corresponding to the best bingo card (See Kellen col. 3 lines 45-49; Fig. 1) [claims 6, 35, 58, 66]. The monitor displays one or more of the bingo cards closest to achieving bingo (See Kellen col. 3 lines 45-49; Fig. 1) [claims 7, 34, 56, 57, 65]. The monitor displays the numbers needed to be generated for a best bingo card to achieve bingo (See Kellen col. 3 lines 45-49; Fig. 1) [claims 8, 36]. It would have been obvious to one of ordinary skill in the art to display the cards that are closest to winning bingo. By viewing these cards, the player can watch in anticipation as the next number is called and can visually see if they are about to win bingo. By only viewing the cards closest to winning bingo, a player can focus his attention on those cards and not have to be bothered with cards that are not likely to win.

Claims 10-13, 26, 59, 60-62 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fioretti (alternatively in view of Moore et al.) in further view of Barcelou, U.S. Patent No. 6,048,271. Fioretti

discloses that the point of sale terminals include a data processing means that generates and prints one or more statements each including an identification and verification number (See Fioretti col. 9 lines 31-64). The data processing means displaying on a monitor an outcome corresponding to the statement upon first inputting the identification number (See Fioretti col. 12 lines 13-27) [claim 26]. Fioretti lacks in separately inputting both an identification and verification number. It would have been obvious to one of ordinary skill in the art to require players to input two numbers, i.e. identification and a verification number in order to validate a winning card [claim 26]. By requiring two numbers instead of one, an extra security measure is in place and players will have a more difficult time trying to forge two numbers.

Fioretti discloses that the point of sale terminal has a printer but lacks in disclosing more specific peripheral devices. Barcelou teaches of a point of sale terminal that includes a magnetic/smart card reader, a barcode reader, a bill acceptor, a printer, a bill dispenser, a touchscreen and a keyboard (See Barcelou Figs. 1, 2a; col. 4 lines 5-8; col. 5 lines 26-43; col. 6 lines 48-55) [claims 10-13, 59-62, 64]. It would have been obvious to one of ordinary skill in the art to include any or all of these peripheral devices on the point of sale terminal of Fioretti. By using these peripheral devices, which are all well known throughout the art, the player can easily purchase or redeem bingo cards from a point of sale terminal. The peripheral devices make accessing a player's account or record easier.

Claims 23, 24, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fioretti (alternatively in view of Moore et al.), in further view of Wei et al., U.S. Patent No. 6,398,646 B1. Fioretti lacks in disclosing printing a player tracking number or players name on the card. Wei teaches of a bingo game in which information printed on the statement includes a player tracking number and the player's name (See Wei Fig. 5; col. 2 lines 25-59) [claims 23, 24, 47, 48]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the player's tracking number or the player's name on the statement so that if the statement were to be lost, it could be accurately returned to the proper owner. By including this information on a statement, the statement can be properly associated with a player.

Claims 25, 28, 29, 49, 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fioretti (alternatively in view of Moore et al.), in further view of Tawil, U.S. Patent No. 5,951,396. Fioretti lacks in disclosing barcodes printed on the statement. Tawil teaches of bingo cards in which at least portions of the information printed on the statement is in the form of a barcode (See Tawil Fig. 2) [claims 25, 49]. The data processing means of Tawil scans identification and verification codes printed on the statement to retrieve the results of the bingo cards corresponding to the statements (See Tawil col. 5 lines 33-36) [claims 28, 52]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have information

in barcode form. Barcodes are easily scannable by barcode readers and do not leave room for human error in inputting the code to a computer for verification. Furthermore, barcodes can represent information in a non-human readable format to provide greater security. It would have been obvious at the time the invention was made to have an operator override the data processing means and manually enter the identification and verification codes [claims 29, 53]. It is well known throughout the art for some barcodes to be wrinkled or not readily scannable and an operator can manually input the code into a computer. By allowing a manual override, unforeseen problems that may occur when bar codes are not capable of being scanned can be avoided.

Response to Amendment

It has been noted that claims 56-67 have been amended.

Response to Arguments

Applicant's arguments filed March 21, 2005 have been fully considered but they are not persuasive. Applicant argues that Fioretti does not teach automatically starting the next game. The Examiner disagrees and notes that it is implicit that Fioretti automatically starts the next game since it downloads a bingo schedule and sequences through the set of bingo games (See Fioretti col. 5 lines 53-5; col. 10 lines 25-29). However, if it is determined that Fioretti does not automatically start the next game, the Examiner notes that it would

have been obvious to in view of Moore et al. which clearly shows that a bingo session can be implemented automatically. The Examiner further notes that the concept of making something "automatic" is an obvious improvement as decided by case law. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.

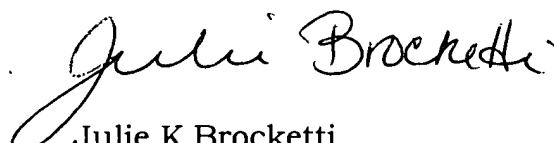
The Examiner further notes that numerous patents to Richardson were incorporated by reference into the patent of Fioretti.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K. Brockett whose telephone number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julie K Brockett
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